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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,968	10/25/2001	Clive P. Hohberger	7887/83891	1764

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EXAMINER

PURVIS, SUE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,968

Applicant(s)

HOHBERGER ET AL.

Examiner

Sue A. Purvis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-34 and 153-163 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 160-163 is/are allowed.
- 6) ☒ Claim(s) 21-24, 26-34, 153, 154, 156, 157, and 159 is/are rejected.
- 7) ☒ Claim(s) 25, 155 and 158 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 28-34 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for having the media samples on a first web then the media samples be temporarily removed from that web (Figure 3), does not reasonably provide enablement for having a second web that temporarily removes the media samples from the first web. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification discloses several embodiments of the apparatus, but the examiner was unable to find a teaching for a “second web that temporarily removes” the media samples as required by this claim. Figure 20 shows an embodiment where a “second web” is used to attach the value-adding mechanism, however that web does not remove the media sample from the first web. It is the peeler bar (32) which affects the removal of the web.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 156 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 153, applicant identifies a “means for supporting” and a “means for pressing.” Claim 154, applicant identifies the “means for pressing” as a tamper. Claim 156 identifies the “means for supporting” as utilizing a vacuum. The vacuum is delivered through the bellows of the tamper. From this, it seems that the “means for supporting” is the tamp, however applicant has already identified the tamp as the “means for pressing”. Clarification is required. If the applicant meant the vacuum to be the “means for supporting,” the examiner suggests changing the language of the claim.

Claim Objections

5. Claims 156 and 157 are objected to because of the following informalities: They depend from cancelled claim 136. Appropriate correction is required. For examination purposes, the examiner is assuming claim 156 depends from claim 154 and claim 157 depends from claim 153.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 21-24, 26 27, 153, and 157 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duschek (US Patent No. 6,334,921 B1) in view of Grabau et al. (US Patent No. 6,451,154 B1).

Duschek discloses labels (2) being advanced on a web (5), the web is then removed from the labels by means of a dispensing edge (3) and guide rollers (19). Then an applicator unit (6) attaches security elements (8) to the web (5) which then applies the elements to the labels (2).

Duschek does not discuss if the labels have been printed on. The claim requires that the media samples (labels) before the value-adding device is added to it.

Grabau discloses manufacturing concepts for RFID labels (48). In particular, Grabau teaches that the surface (12, 14) of each label (48) has indicia 50 (either variable indicia imaged at (43) or earlier imaged non-variable indicia). (Col. 5, lines 21-33.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to print onto the label in Duschek before adding the security element to the label, because Grabau teaches that it is within the purview of the artisan to print the indicia on the label before adding radio frequency identification to the label.

Regarding claims 22 and 23, “expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim.” *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Thus, the device of Duschek in view of Grabau is capable of attaching the value-adding device as it is described in these claims. (See MPEP §2115.)

Regarding claim 24, Grabau teaches the desirability of verifying the functionality of the chips prior to the formation of the web. (Col. 2, lines 40-42.) Therefore, it would have been

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obvious to one having ordinary skill in the art at the time the invention was made to include a means for verifying if the transponders are operable as required by this claim.

Regarding claim 26, the device of Duschek in view of Grabau is capable of attaching the value-adding device to less than all the media samples. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Regarding claim 27, in Duschek the media samples are labels.

Regarding claims 153, Duschek does not discuss pressing the element and media together to cause adherence, but this feature is taught in Grabau. (Figure 2; Col. 4, lines 16-24.) It would have been obvious to one having ordinary skill in the art at the time the invention was made to press the elements in Duschek together to ensure the security element is adhered properly to the label, because if the element is not adhered properly it would be lost in subsequent processing steps, such as when the label is applied to an article.

Regarding claim 157, Duschek discloses an adhesive backed label and means for relaminating the label.

8. Claim 154 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duschek in view of Grabau as applied to claim 153 above, and further in view of Kathmann et al. (US Patent No. 6,123,796).

Duschek in view of Grabau discloses using a rollers from pressing the label to the security element.

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Kathmann teaches forming of label and target combinations and in the application of the labels, targets and combinations thereof to articles wherein the pressing to the articles or to a web may be carried out by rollers, air jets, or reciprocating tamping devices. (Col. 4, lines 45-49.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a tamp to press the label and security element together in the device of Duschek in view of Grabau, because an alternative to using pressure rollers is a tamp for applying pressure as discussed in Kathmann. The pressure rollers and tamp are functionally equivalent alternative expedients and it is within the purview of the artisan to use them interchangeably.

9. Claim 159 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duschek in view of Grabau as applied to claim 153 above, and further in view of Chamberlain et al. (US Patent No. 5,660,663).

The security element in Duschek is brought into contact with the label, but does not withdraw, leaving the element. A roller (9) brings the security element into contact with the liner and then withdraws leaving the element, but the movement the roller makes cannot be termed "reciprocating". Grabau shows an embodiment in Figure 11 where the element is placed on the web by a roller which withdraws leaving the element on the web, but again there is no reciprocating movement.

In Chamberlain, Figures 6 and 7 shown a dispensing head which reciprocates movement to apply security elements to the cover layer (23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a means for placing the element on the web which uses a reciprocating movement, because Chamberlain teaches that reciprocating movement as a way to place a security element onto the label. It is within the purview of the artisan to use a dispensing head with a reciprocating movement instead of a dispensing roller, because they both achieve the same end result and well known in the art.

Claim Observations

10. Claim 21 identifies a “second web means for temporarily removing the plurality of media samples from said first web.” As described above, the examiner was unable to discern a “second web” for removing the samples from the first web. Since the applicant added the word “means” in this claim, the examiner rejected it identifying the peeler bar and rollers in Duschek as the “means,” however the applicant’s use of “second web” is a bit misleading and the examiner suggests using different language there.

Allowable Subject Matter

11. Claims 25, 155, and 158 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claim 156 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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13. Claims 160-163 are allowed.

14. The following is an examiner's statement of reasons for allowance:

Regarding claim 25, while Grabau teaches that indicia can be printed on the label before or after the security element is attached, the indicia printed before the element is attached is non-variable which is in contradiction as to what is required by claim 21. This claim requires that the indicia printing on the label before the element is attached be variable, based on the operability of the element. This is neither taught nor suggested by the prior art.

Regarding claim 155 and 160, prior art does not teach or suggest a reciprocal tamping applicator as required by these claims. The applicator needs a fast act solenoid, a gas spring driven by the solenoid, and a pressure applying mechanism. This combination of features is not taught or suggested in a device for applying a value-adding device to a label or ticket.

Regarding claim 156, there is no teaching or suggestion for using a tamp with a vacuum as required by this claim in this type of apparatus.

Regarding claim 158, Grabau teaches checking to see if the element is operable, but there is no teaching or suggestion in Grabau for including means for programming or reprogramming the element which is applied to the label. The device of Duschek in view of Grabau is not capable of performing such a function.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


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Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is 703-305-0507. The examiner can normally be reached on Monday through Thursday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-1495.



Sue A. Purvis
Examiner
Art Unit 1734

sp
June 2, 2003